

Appl. No. 10/753,737

Docket No. 54317-025904

Amtd. dated November 10, 2004

Reply to Office action of August 10, 2004

## REMARKS

In response to the Office Action mailed August 10, 2004, the Applicant submit the present response and amendments and request reconsideration.

### I. Group Restriction under 35 USC § 121

The Examiner asserts that the present application contains claims directed to two patentably distinct inventions, Group I (claims 1-24 and 68-73) and Group II (claims 25-67).

As required under 35 USC § 121, the Applicant elects Group II claims 25-67. Claims 1-24 and 68-73 have been cancelled without prejudice from the present application. Election of Group I has required rewriting of claims 51, 52, and 53 for clarity purposes, in order for those claims to incorporate the language of cancelled claims 1, 13, and 18, respectively.

Additionally, claims 54-64 have been cancelled without prejudice. As a consequence, further prosecution of the present application should be based on claims 25-53 and 65-67.

### II. Species Restriction under 35 USC § 121

The Applicant has read with attention the Examiner's identification of patentably distinct species at pages 3 and 4 of the Action and respectfully believes that the Examiner has misconstrued the correspondence between the invention as claimed and the Figures.

A correct correspondence between claims 25-53 and the Figures is provided as follows.

Claims 25-28 recite a leaf spring element shown, by way of example, in Figures 35, 36, 37, and 40.

Claims 29-30 recite a process for manufacturing a leaf spring element. The process is shown, by way of example, in Figures 33-37 and 40.

Claims 31-33 recite a hinging assembly shown, by way of example, in Figures 37 and 40.

Claims 34-40 recite a base element to be used with a watch case. The base element is shown, by way of example, in Figures 43, 44A, 44B, 45A, 45B, 46, and 47.

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Claims 41-53 further recite a hinging assembly shown, by way of example, in Figures 44A, 44B, 45A, 45B, 46 and 47.

Claims 65-67 recite a watch band shown, by way of example, in Figures 40, 45A, and 45B.

A leaf spring element, a process for manufacturing a leaf spring element, a hinging assembly and a watch band are not necessarily alternative embodiments of the invention. Therefore, the corresponding claims are not mutually exclusive and may not be restricted to separate species of invention within the basic disclosed invention, as also stated in MPEP 806.04(f). For example, leaf spring claim 25, process claim 29 and hinging assembly claim 31 all read on Figure 37. Additionally, the Examiner should note that claim 31 also recites "a leaf spring element according to claim 25" (emphasis added). Similar considerations apply to a base element a hinging assembly and a watch band.

Further, even assuming, *arguendo*, that claims 25-53 and 65-67 as grouped above are restricted to different species, the number of species to which the pending claims relate to, is reasonable, thus allowed by 37 CFR 1.146, second sentence.

As a consequence, the Applicant submits that keeping claims 25-53 and 65-67 together in the present application is proper.

However, as required under 35 USC § 121, the Applicant provisionally elects the 'species' identified by the Examiner as "Embodiment 29: Figures 37-39." As noted above, such 'species' reads on leaf spring element claims 25-28, process 29-30, and hinging assembly 31-33. However, as already pointed out by the Applicant, those 'species' are not mutually exclusive and reconsideration of the Examiner's arguments is respectfully requested.

\* \* \*

Should matters remain which the Examiner believes could be resolved in a further telephone interview, the Examiner is requested to telephonic the Applicant's undersigned attorney.

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The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that the Attorney Docket Number is referred to when charging any payments or credits for this case.

Respectfully submitted,

GREENBERG TRAURIG, LLP

Date November 10, 2004By 

Enrica Bruno

Limited Recognition (attached)

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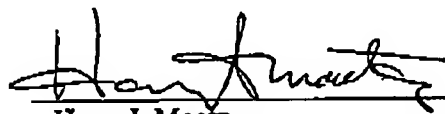
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**Expires: March 23, 2005**



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